

Restriction is only proper if the claims of the restricted groups are either independent or patentably distinct. The burden of proof is on the Office to provide reasons and/or examples to support any conclusion with regard to patentable distinctness. MPEP §803.

Applicants respectfully traverse the requirement for restriction on the grounds that the Office has not provided adequate reasons and/or examples to support a conclusion of patentable distinctness between the identified groups.

Citing MPEP §§806.04 and 808.01, the Office has characterized Groups I and IV as "unrelated" inventions. However, Applicants note that the MPEP describes unrelated inventions as, for example, "an article of apparel such as a shoe, and a locomotive bearing", or "a process of painting a house and a process of boring a well." MPEP 806.04(A). Thus, unrelated inventions, as defined by the MPEP, are inventions which are directed to *completely* different technical fields, and have no reasonable relationship with each other. Applicants make no statement regarding the patentable distinctness, but note that Groups I-III and V are classified in class 435, and therefore these groups can be reasonably searched in the same technical field. Thus the inventions of Groups I and IV of the present invention do not meet the standard of "unrelatedness" of MPEP 806.04(A), discussed above, nor do they present a burden on the Office. Accordingly, Applicants respectfully submit that the Restriction is improper, and request that it be withdrawn.

In regard to Groups II, III, and V, the Office has characterized these groups as unrelated. Citing MPEP §§806.04 and 808.01, the Office suggests that "the methods of Groups II, III, and V are distinct both physically and functionally; require different process steps, reagents, and parameters; and produce different products." However, Applicants respectfully submit that the Office has merely made a conclusion, and has not provided examples/explanation to suggest that these Groups are unrelated, as alleged. Accordingly,

Applicants respectfully submit that the restriction requirement is improper, and it should therefore be withdrawn.

In regard to Groups I, II, III, and V, the Office has characterized these groups as unrelated. Citing MPEP §§806.04 and 808.01, the Office suggests that “each of processes of Groups II, III and V do not require the product of Group I.” However, Applicants respectfully submit that the Office has merely made an unsupported conclusion. The Office and has not provided examples/explanation to suggest that these Groups are unrelated. Accordingly, Applicants respectfully submit that the restriction requirement is improper, and it should therefore be withdrawn.

The Office has characterized the inventions of Groups III and IV as related as process of making and product made. Citing MPEP §806.05(f), the Office concludes that the product as claimed can be made by a “materially different process such as using chemical synthesis methods”. However, there is no evidence of record to show that the claimed product can be made by a “chemical synthesis” process as the Office has alleged. If in fact the claimed product can be made by a “chemical synthesis” process, Applicants respectfully submit that the Office has not shown how the “chemical synthesis” process is materially different from the claimed process. Accordingly, Applicants respectfully request withdrawal of the Requirement for Restriction.

Further, Applicants respectfully traverse the Requirement for Restriction on the grounds that the Office has not shown that a burden exist in searching all of the claims. Applicants respectfully point out Groups I-III and V are classified in class 435; and could be searched together.

Finally, Applicants note that MPEP §821.04 states, “if applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product

claim will be rejoined." Applicants respectfully submit that should the elected group be found allowable, the non-elected claims should be rejoined.

Accordingly, and for the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary in order to sustain the Requirement for Restriction. Withdrawal of the Requirement for Restriction is respectfully requested.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice thereof is earnestly solicited.

Respectfully submitted,

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